



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Confirmation No.: 6467

SUZUKI

Art Unit: 2622

Application No.: 09/824,007

Examiner: B. Jelinek

Filed: April 3, 2001

Docket No.: 107317-00026

For: MOS-TYPE IMAGE PICKUP DEVICE CAPABLE OF TAKING FULL PICTURE
AT ONE TIME (As Amended)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

September 21, 2007

Sir:

The Applicant requests review of the Office Action mailed May 21, 2007, in the patent application identified above. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

REMARKS

Claims 1, 4-8 and 10-20 are pending in the subject application. The outstanding Office Action is Final, and is the second Office Action after the filing of a second RCE in this application. Thus, the application qualifies for Appeal.

In the Final Office Action mailed May 21, 2007, the Examiner rejected claims 1, 4-8, 10-13 and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,452,004 to Roberts, (hereinafter, "Roberts "). Claims 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of U.S. Patent No. 4,827,348 to Ernest et al. (hereinafter, "Ernest"); and claims 17-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roberts in view of Ernest and further in view of U.S. Patent No. 5,382,974 to Soeda et al. (hereinafter, "Soeda").

The Applicant submits that these rejections are made in error for at least the reasons set forth below.

I. Claimed Limitations Not Met by Cited References

In the outstanding Office Action, the Examiner has cited references that do not meet all of the claimed limitations.

In the February 20, 2007, Response to the November 11, 2006, Office Action, independent claims 1, 14 and 20 were amended to recite that the row shift circuit has "no random access function."

Regardless, in the May 21, 2007, Office Action, the Examiner maintained the position that independent claims 1, 14 and 20 are anticipated by Roberts, which has a random access function. The Examiner cites no disclosure in Roberts of an imaging

device that has no random access function, as recited in independent claims 1, 14 and 20.

As explained in the February 20, 2007, and August 21, 2007, Responses, the random access imaging device of Roberts necessarily includes a circuit that is much more complicated than that of an imaging device that does not have a random access function, as in the claimed invention. In response to Applicant's arguments, the Examiner maintained the position that Roberts "clearly" discloses that the whole image may be read out, as opposed to only selected image regions, at col. 1, lines 15-20 thereof. See, e.g., *Office Action dated May 21, 2007*, p. 2.

The Examiner has failed to take into account that all embodiments disclosed by Roberts include a complex circuit for allowing a random access function. That, according to the Examiner (and not admitted by the Applicants), the device of Roberts may be able to perform sequential access does not negate the fact that the device disclosed by Roberts includes the complex circuitry necessary for allowing a random access function, and the fact that Roberts does not disclose a row shift circuit including a row read scan circuit capable of supplying a read signal to a plurality of row selection signal lines sequentially, and a reset scan circuit capable of supplying a reset signal to the plurality of reset signal lines sequentially, the row shift circuit having no random access function, as recited in independent claims 1, 14 and 20.

For at least this reason, the Applicant respectfully submits that the rejections based on Roberts are factually erroneous and therefore improper, and withdrawal of such rejections is requested.

II. Omission of Essential Elements Needed for Prima Facie Rejection

In order for the Examiner to establish a prima facie case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as the Examiner proposes. Second, there must be a reasonable expectation of success in connection with the Examiner's proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143.

The combination of cited references fails to disclose or suggest each and every element of the claimed invention. The limitations of independent claims 1, 14 and 20 are not met by any of the cited references or combination thereof. As explained above, Roberts neither discloses nor suggests at least the feature of a row shift circuit having no random access function, as recited in independent claims 1, 14 and 20. Ernest and Soeda, alone or combined, are not cited for, and do not cure the deficiencies of Roberts noted above.

For at least these reasons, as well as the reasons set forth in the February 20, 2007, and August 21, 2007, Responses, the Applicant submits that independent claims 1, 14 and 20, are allowable over the applied art of record and any combination thereof.

As claims 1 and 14 are allowable, the Applicant submits that claims 4-8 and 10-19, which depend from allowable claims 1 and 14, respectively, are likewise allowable.


III. Conclusion

For all of the above reasons, review of the outstanding Office Action is respectfully requested, and a favorable decision, and allowance of all pending claims, are earnestly solicited.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Docket No. 107317-00026.**

Respectfully submitted,

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Enclosures: Notice of Appeal to the BPAI
Pre-Appeal Brief Request for Review (Form PTO/SB/33)